

II. Request For Interview

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Assaf in agreeing to hold a personal interview, after the filing of this Request, to discuss the merits of the application.

III. Rejection Under 103(a)

Claims 1-4, 10-16 and 75-77 are rejected under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2001/0002895 to Kawano et al. ("Kawano"). This rejection is respectfully traversed.

Independent claim 1 recites, *inter alia*, a "holographic recording method for multiple-recording a file comprising one or more pages of data in an optical recording medium as at least two holograms, wherein page data of separate files are not multiplexed, and are recorded respectively in different positions in the optical recording medium."

Independent claims 73 and 76 recite similar features.

The Office Action acknowledges that Kawano does not teach that "page data of separate files are not multiplexed, and are recorded respectively in different positions in the optical recording medium," as recited in the claims, but asserts that "it would have been obvious, at the time the invention was made, to a person of ordinary skill in the art to store the hologram without multiplexing in order to reduce crosstalk (i.e., noise) during reconstruction of the holograms." Applicants respectfully assert that the rejection is improper for any or all of the following reasons.

**A. The Rejection Fails The Test Set Forth by
The Manual of Patent Examining Procedure at §2143**

First, the Office Action fails to meet the basic requirements for a prima facie case of obviousness. As stated by the Manual of Patent Examining Procedure at §2143, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added).

The Office Action does not provide any evidence to satisfy any of the three tests set forth above. For example, the Office Action fails step three, identified above, because it provides no cited references to fill the deficiency explicitly acknowledged by the Office Action with respect to Kawano.

**B. The Alleged Motivation "To Reduce Crosstalk"
Is Not Supported By Evidence**

The Office Action offers no evidence that storing a hologram without multiplexing reduces cross talk during the reconstruction of the hologram.

Additionally, at paragraph [0007], Kawano discloses that "**multiplexed holographic storage**" may be used to increase the capacity of a storage device. At paragraph [0176] Kawano discloses that holograms can be multiplexed in the same region and the multiplexed holograms can be separately read out from the same region. Thus storage of data with higher precision is available. Nowhere does Kawano disclose, teach or suggest a storage technique that does not include the use of multiplexing. Therefore, the Office Action fails Steps 3: "references (when combined) must teach or suggest all the claim limitations" and Step 1: there must be a motivation to combine the references.

**C. The Proposed Modification Would Change
The Principle of Operation of the Reference**

Because Kawano uses multiplexing, as discussed above, the proposed modification of not using multiplexing would change the principle of the operation of Kawano. This result is not acceptable in a §103 analysis. See MPEP §2143.01.VI.

**D. The Applied Prior Art Does Not Suggest Or Achieve
Advantages Achieved By The Claimed Invention**

An advantage of the claimed invention is described in the specification at, for example, page 4, lines 15-19. Specifically, it becomes possible to selectively rewrite or erase only desired data without degrading the other data. Kawano does not suggest or achieve such an advantage. The teaching of such an advantage by Applicants, and the lack of such a teaching (or a teaching of any other advantage to be gained by the claimed combinations of features) in Kawano, combine as strong evidence that the rejection is based on an impermissible use of hindsight knowledge obtained from Applicants' disclosure.

* * *

For any or all of these reasons, withdrawal of the rejection is respectfully requested.

IV. "Official Notice"

Various parts of the rejection appear to rely on Official Notice, since no evidence is provided. Should any rejection relying on "Official Notice" be applied or maintained, Applicants require that a reference be provided in support of this assertion.

V. Improper Restriction

The Office Action, at page 2, restricts new claim 78 for being directed to an invention that is independent or distinct from the invention originally claimed. Specifically, the Office Action states that claim 78 appears to read on non-elected species 2. Applicants respectfully disagree.

The features of claim 78 correspond to features that have been included in claims 66, 70 and 72. Up until the time that these claims were cancelled, these claims were examined, and were considered consistent with the elected species. (For example, see page 2 of the Office Action mailed June 29, 2005.) Claim 78 is therefore consistent with the elected species.

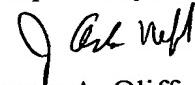
Accordingly, Applicants respectfully request the restriction requirement regarding new claim 78 be removed.

VI. Conclusion

In view of the foregoing, favorable reconsideration and prompt allowance of claims 1-16 and 73-78 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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